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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 21

Application Number: 09/443,456
Filing Date: November 19, 1999
Appellant(s): WEGENER ET AL.

James F. McKeown
For Appellant

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EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/12/2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct except the rejection of claims 19-22 has been withdrawn and such claims are now allowed.

(4) *Status of Amendments After Final*

The appellants' statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellants' statement of the issues in the brief is correct except with regard to issues one, three, four and seven.

With regard to issue one, the rejection of claims 1-8, 10, 11, 17, 18 and 27-30 under 35 USC 102(b) based upon Okamoto has been withdrawn.

With regard to issue three, the rejection based upon Binder has been withdrawn. Further, with regard to issue three, Appellants' statement of the claims is incorrect and claims 1, 5-8, 10, 11, 13-17, 23, 25 and 27-30 should be referenced as being rejected.

With regard to issue four, the rejection of claims 19-22 under 35USC 103(a) and based upon Arai et al, JP 5-96329 has been withdrawn and claims 19-22 are allowed.

With regard to issue seven, the rejection of claims 1-30 under 35USC 112 has been withdrawn.

(7) Grouping of Claims

Appellants' brief includes a statement that claims 1-30 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8). The grouping by Appellants of the claims at page 17 of their Supplemental Appeal Brief, that groups claims he considers to stand and fall together, is noted.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

US 5,301,863	PRINZ et al	4-1994
EP 615799 A1	HASHIMOTO et al	9-1994
US 4,170,157	KOSER	10-1979

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-8, 10, 17, 18, 23, 25 and 27-30 are rejected under 35 U.S.C. 102(b) as anticipated by Hashimoto et al, EP 615799 A1. This rejection is set forth in prior Office Action, Paper No. 19.

Claims 1, 5-8, 10, 11, 13-17, 23, 25 and 27-30 are rejected under 35 U.S.C. 102 (b) as anticipated by Prinz et al. This rejection is set forth in prior Office Action, Paper No. 19.

Claims 24 and 26 are rejected under 35 U.S.C. 103 (a) as being obvious in view of Hashimoto et al, EP615799A1. This rejection is set forth in prior Office Action, Paper No. 19.

Claims 9 and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto et al in view of Koser, 4,043,167. This rejection is set forth in prior Office Action, Paper No. 19.

(11) Response to Argument

The considerable breadth of many of the rejected claims is noted by the Examiner, and the comments in the three paragraphs following are directed to address such claim breadth.

The broadest apparatus claim 1 calls for merely three elements: the first is a "forming system" with a "plurality of stations," the second is a "forming tool," the third is a "separate station" "machining device with a local energy feed." Such elements are described in Appellants' specification at pages 6, 7 and 18. At page 6, lines 11-13 the "forming system" described may have "several forming stations..." as illustrated in figures 1-6. Forming systems may also, by Appellants' disclosure, comprise a single

“forming tool” or “forming station” as set forth in Appellants’ specification at page 18, lines 11-14. This embodiment with a single “forming station” or “forming tool” is illustrated at least in figures 16-18.

Page 6, lines 20-24, states that “forming stations may, for example, be mechanical presses, hydraulic presses, other hydraulic device or internal-high-pressure forming stations.” Clearly, however, a “forming tool” may be reasonably read to comprise known tools that “form” a workpiece. While Appellants’ specification may include as examples of “forming tools” the noted “mechanical presses, hydraulic presses...” those limitations are not claimed and may not properly be imported from the specification into the claims as “reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from ‘reading limitations of the specification into a claim,’ to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim.” *In re Prater*, 415 F.2d1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). Thus, the claimed “forming tool” must be “given the broadest reasonable interpretation consistent with the specification.”

The “machining devices” are stated by Appellants at page 7 of their specification to “be constructed as laser beam, water jet, plasma jet, or sandblasting machining devices 7 or as machining devices for charging electromagnetic energy...” and are in each case provided as a separate station in the forming system 1.” However, for “purposes of simple description” all of the illustrated “machining stations” are stated to be “constructed as laser beam or laser machining device 7.” Such laser machining device is explicit in Hashimoto et al. However, the claim terminology “machining devices” may

be construed as common machining devices used for machining a workpiece as in Prinz et al or Koser as the claims, again, must be "given the broadest reasonable interpretation consistent with the specification."

Appellants' arguments with regard to the rejections based upon Prinz et al at page 21 of his brief are noted. Appellants concede that Prinz et al is "clear in referring to 'forming' articles," but Appellants urge that this "forming" is in a different "sense." Prinz et al explicitly teaches at column 1 the known use of a "forming station" to operate upon a workpiece and additional machining stations to perform subsequent machining upon the formed workpiece. Appellants may *intend* to claim only a specific "forming system" that uses their disclosed "mechanical or hydraulic presses" for forming or "shaping or molding... by the application of pressure" as set forth in the dictionary definition they provide at page 21, lines 9 and 10, of their Brief. However, the claims are not limited to such process or device without Appellants explicitly claiming limitations to such process or device that uses "mechanical presses or hydraulic presses" or "application of pressure" for forming. Otherwise, it is believed that known "forming systems" may be fairly and reasonably relied upon to meet the claim limitations.

Further, it is believed evident that the system in Prinz et al includes a plurality of stations as is clear from figure 2. Prinz et al also teaches the use of certain forming or "processing tools" 40, 64, 42, and diverse "machining devices" are shown at least at station 56, station 52 and station 50. The final rejection notes that in Prinz et al a "CNC machine at (station) 50" comprises a "machining device." While it is well-known that CNC machining devices are "movable in multiple planes" as required by claim 27, Prinz

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et al explicitly states at column 6, lines 50-59 that the "shaping means passes over the complementary material shaping and contouring the complementary surface." To achieve such "shaping and contouring" of the three dimensional workpiece surface would clearly and inherently require and meet the claim 27 language "moving the at least one machining device (Prinz et al's shaping means of machine 51) in multiple planes."

Appellants' arguments concerning Hashimoto et al at page 20 of their Brief are noted. It is believed that Hashimoto et al clearly define all of the three elements of the apparatus claim 1. In Hashimoto et al the "forming system" comprises a press machine 1 with a progressive die 3 with multiple processing portions 5-8 or "forming tools". In a separately operable station adjacent the press machine, but within the "forming system," Hashimoto et al provides a laser processor 12 with a movable head 13 that comprises "at least one machining device." The Examiner concedes that the marginally idiomatic claim language "a machining device with a local energy feed" is not explicit in Hashimoto et al or any of the other applied prior art references. It is noted that Appellants have presented no evidence that a "local energy feed" comprises well-known or defined terminology in the forming or machining art. Regardless, such limitation is inherently described and inherently encompassed by movable laser heads or other mechanical machining devices that operate upon a certain discrete part of a workpiece or upon Appellants' described "small" zone or in a machining "range" that is "small" in comparison to "the dimension (sic) of the workpiece" Thus, a "local energy feed," by Appellants' description in the specification at page 3, lines 10-15, is inherently found in

the applied prior art, as such description fits most known machining devices with discrete tool heads operating upon areas of the workpiece smaller than the workpiece. It is noted that the movable laser machining head of Hashimoto et al is similar if not identical to the figure 4 embodiments of Appellants' described laser machining devices 7 and readily comparable to Appellants' described laser machining devices.

Appellants assert that in Hashimoto et al the "laser processor 12 is upstream of and outside the press machine 1." It is noted that in Appellants' figure 4 embodiment, the "laser machining station is a "first machining station 7" and is clearly upstream of a forming station 2 but still "within" the "forming system." Appellants' argument would be well-taken if the claims 1-18 terminology "within the forming system" was "within the forming tool" but this limitation is found only in claims 19-22 which are not rejected under the prior art. Thus, the claim language " within the forming system" is broad enough to include a "forming system" as set forth in each of the applied art references.

The broadest method claim 27 calls for one defined element: a "machining device with a local energy feed," and the steps of "machining the workpieces" in a "system cycle" and "moving the "machining device" in "multiple planes." As set forth above, Hashimoto et al clearly teaches the machining device with a local energy feed. A "system cycle" inherently occurs in the progressive workpiece processing device of Hashimoto et al or Prinz et al. The laser head 13 of Hashimoto et al is said in column 4 to move "at least in two directions" to perform processing operations. It is noted that any device movable in two directions must move in and through "multiple planes," and the claim limitations are met. Appellants remark at page 21, lines 20 and 21, "that one

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can move in an infinite number of directions even within (sic, within a) surface plane.”

Apparently Appellants would also recognize that an infinite number of intersecting planes may pass through a “surface plane.” Thus a tool movable in a “surface plane” may also move in lines contained in an infinite or “multiple” number of intersecting planes as in the device of Hashimoto et al as well as the device of Prinz et al .

With regard to the 35 USC 103 rejection based upon Hashimoto et al, of claims 24 and 26, Appellants argue that the “ ‘obvious design choice’ allegation... is totally deficient.” However, Appellants have not contradicted the assertion of the final rejection that one possessing ordinary skill in the art would readily utilize the claimed arrangement of machining stations as an obvious modification of the machining device station associated with a forming station arrangement explicit in Hashimoto et al based upon the number of machining operations that may be required to achieve different workpiece configurations. For example, if machined holes of different sizes and varied machined contours were required to achieve a particular workpiece configuration, the skilled artisan would be expected to utilize the required arrangement and number of machining devices and stations consistent with providing the required machining operations to complete the final and desired workpiece configuration.

With regard to the 35 USC 103 rejection based upon Hashimoto et al in view of Koser of claims 9 and 11-16, Appellants’ arguments at page 21, lines 20-24 and page 22, lines 7 are not well-taken. The contention of the final rejection is that one possessing ordinary skill in the art would readily modify the “manipulation device” that mounts the “machining element” that is part of the “machining device.” The “manipulation device”

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or drive device in Hashimoto et al mounts the machining head 13 and is "adapted to move at least in two directions" as set forth at column 4 of Hashimoto et al. Thus, at issue is whether it would be obvious to modify such teaching of machining device movement in Hashimoto et al to include the "manipulation device" permutations of claims 9, 11-16, some of which are explicit in Koser, that comprise manipulation devices of different kinematic configurations well-known to the machining device artisan. Koser clearly teaches a "forming system" with a forming tool or die 2 and two slidable and swivelling "machining" or trimming devices 5. Thus, such teaching of Koser is believed to fairly be available to one possessing ordinary skill in the art who would be expected to utilize the teaching of such known "manipulation device" to achieve machining device movements, such as taught by Koser, additional to the movements explicitly provided for in Hashimoto et al.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

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November 3, 2002

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